

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 81

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOYO KATSURA, SHIGERU MATSUO,
SHIGEAKI YOSHIDA, HIROSHI TAKEDA AND HISASHI KAZIWARA

Appeal No. 2000-0064
Application 08/625,241

HEARD: MARCH 19, 2002

Before JERRY SMITH, FLEMING and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 19-22 and 31-33, which constitute all the claims remaining in the application. An amendment after final rejection was filed on August 14, 1997, but was denied entry by the examiner.

The disclosed invention pertains to a graphic display system and to a method for controlling a graphic display system.

More particularly, graphic information to be outputted is stored in a first area of a frame buffer, and font pattern information of a character is stored in a second area of the frame buffer. Coded information of a character is provided by an external providing means to a processing means which is connected to the providing means on a first bus while the processing means is connected to the frame buffer on a second bus. Font pattern information is transferred by the processing means in parallel with the processing of addresses of font pattern information from the second area of the frame buffer.

Representative claim 19 is reproduced as follows:

19. A method of controlling a graphic display system comprising the steps of:

memorizing graphic information to be outputted to an output means in a first area of a frame buffer;

memorizing font pattern information of a character in a second area of said frame buffer in accordance with coded information of said character;

providing, by providing means, coded information of a character to processing means from external of said system, said processing means being connected to said providing means via a first bus and to said frame buffer via a second bus;

processing, by said processing means, addresses of font pattern information memorized in said second area of said frame buffer on the basis of said coded information; and

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transferring, by said processing means in parallel with said processing step, font pattern information specified by said addresses from said second area of said frame buffer to a predetermined output position of said first area of said frame buffer.

The examiner relies on the following references:

Katsura et al. (Katsura 1)	4,947,342	Aug. 07, 1990
Katsura et al. (Katsura 2)	5,751,930	May 12, 1998
Fleming et al. (Fleming)	WO 82/04153	Nov. 25, 1982

Harold S. Stone, Microcomputer Interfacing, 1982 by Addison-Wesley Publishing Company, Inc., pages 1-6.

Claims 19-22 and 31-33 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the invention claimed in Katsura 1 in view of Stone. Claims 19-22 and 31-33 also stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the invention claimed in copending application Serial No. 08/213,820 in view of Stone. Copending application Serial No. 08/213,820 has become U. S. Patent No. 5,751,930 (Katsura 2), and this rejection will now be considered as an actual double patenting rejection based on Katsura 2. Finally, claims 19-22 and 31-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Fleming in view of Stone.

At the oral hearing assigned for this appeal, appellants' representative indicated that appellants wished to withdraw the appeal with respect to the two rejections based on obviousness-type double patenting because they were prepared to file a terminal disclaimer if necessary. In view of this indication by appellants' representative, we will only consider the rejection of claims 19-22 and 31-33 under 35 U.S.C. § 103 based on Fleming and Stone. We do not address the merits of the obviousness-type double patenting rejections or of any of the arguments made with respect to these rejections.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's

rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 19-22 and 31-33. Accordingly, we reverse.

At the outset, we note that appellants have requested that we remand this appeal to the examiner based on appellants' view that the examiner's answer has improperly made a new ground of rejection [Reply Brief, footnote 1]. To the extent that appellants' request asserts that this rejection is not properly before us, we do not agree. Appellants have raised the question that the examiner's answer improperly includes a new ground of rejection in two separate petitions to the Commissioner and in a request for remand addressed to the Board. The two petitions and the request for remand have all been decided on the merits adversely to appellants. Thus, the Commissioner and the Chief Administrative Patent Judge have ruled that the examiner's answer does not set forth a new ground of rejection in violation of 37 CFR § 1.193(a)(2).

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To the extent that appellants' request asks that we use our discretionary authority to remand this appeal to the examiner, we also decline to remand on that basis. The Board can remand an appeal to the examiner to request clarification of the record. In this appeal, however, the record is clear. The rejection made in the examiner's answer is identical to the rejection made in the final rejection except that the reference to Stone, which was clearly used in the final rejection, has now been identified in the statement of the rejection. No clarification of the record is necessary because both the examiner and appellants have made their positions on Stone clear on this record. The change in the statement of the rejection in the examiner's answer was a technical change rather than a substantive change. Therefore, this rejection is properly before us, and we will decide this appeal on the merits.

We now consider the single remaining rejection of claims 19-22 and 31-33 under 35 U.S.C. § 103 as being unpatentable over the teachings of Fleming and Stone. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness.

See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument

and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

The examiner notes that Fleming fails to explicitly disclose the limitation of transferring information in parallel with the processing of information. The examiner cites Stone as teaching that this is known in the art. The examiner finds that it would have been obvious to the artisan to incorporate the teachings of Stone into Fleming's device [answer, pages 8-11].

Appellants argue that the examiner's reliance on a small introductory portion of the Stone textbook is misleading. Appellants also argue that Fleming does not teach the first and second buses as asserted by the examiner. Appellants further

argue that the portion of Stone relied on by the examiner does not support the parallel processing and transferring of information as claimed. With respect to claims 31 and 32, appellants additionally argue that the applied prior art does not teach or suggest the first and second registers as claimed. With respect to claim 33, appellants additionally argue that the examiner has failed to properly apply a "means-plus-function" analysis to this claim [brief, pages 5-12].

The examiner responds that the first bus in the claimed invention corresponds to the communication link in Fleming. The examiner notes that the claim language on appeal now is similar to claim language considered by the Board in a previous decision. The examiner also responds that the processing and transferring steps in Fleming are performed in parallel. The examiner also notes that Stone teaches that parallel processing was well known. With respect to claims 31 and 32, the examiner takes Official Notice that registers for storing addresses were well known, and the examiner cites a Motorola manual for support of this position. With respect to claim 33, the examiner responds that Fleming in view of Stone discloses the same processing as claim

33 and, therefore, the processing means are equivalent [answer, pages 11-14].

Appellants respond that the communication link in Fleming is not a bus as that term should be interpreted. Appellants challenge the examiner's assertion that this question was decided in the previous Board decision. Appellants note that the claim identified in the previous decision was not, in fact, the claim which was on appeal. Appellants argue that the previous Board decision did not state that the processing and transferring steps in Fleming occurred in parallel, but rather, that one step occurred before the other. Appellants also respond that merely because parallel processing was known does not automatically mean that one would have been motivated to use parallel processing in a specific application. Appellants challenge the propriety of the Official Notice taken by the examiner. Finally, appellants argue that the Fleming and Stone references do not have the structural equivalent of the single processor means disclosed in their specification [reply brief].

We agree with the arguments presented by appellants in the briefs. First, we note that the two key features argued by appellants on this appeal were not considered in the previous

Board decision. Although the wrong claim was mistakenly inserted into the previous Board decision, the decision itself quotes from the correct version of the claims on appeal. Thus, the previous Board decision made no findings with respect to the presently claimed first and second buses and the claimed parallel processing and transferring of information. To the extent that the examiner's position considers that the previous Board decision addressed these features, that position is in error.

Appellants are correct to argue that the communication link in Fleming is not a bus. It appears to be a radio link of some kind. Although we would prefer to be considering arguments directed to the obviousness of replacing the communication link of Fleming with a bus, such arguments are not of record because the examiner's finding is that the communication link is a bus. As argued by appellants in the reply brief and unrebutted by the examiner, this finding of the examiner is erroneous.

We also agree with appellants that the portion of Stone relied on by the examiner does not support the obviousness of the parallel processing and transferring as claimed. The examiner refers to the portion of Stone wherein it states "[t]he execution

of a single instruction, in general, involves one or more additional bus transactions that depend on the instruction executed. For example, the processor may read from or write to memory to exchange data between internal registers and memory." We do not find any relevance in this passage to the concept of parallel processing. The passage seems to suggest that execution of a single instruction may require several sequential uses of the bus to complete the execution. The examiner's position that this passage somehow suggests parallel processing is clearly erroneous.

We also note that appellants do not claim to have invented parallel processing. Parallel processing, as a general concept, was well known in the data processing arts. We agree with appellants, however, that the mere knowledge of parallel processing by the artisan does not establish the obviousness of using parallel processing in the manner specifically recited in appellants' claims. The examiner has failed to address the specific question of why the parallel processing as recited in the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103. Therefore, the examiner has failed to establish a prima facie case of obviousness.

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Since each of the claims on appeal recites at least these features discussed above, we do not sustain the examiner's rejection of any of claims 19-22 and 31-33 based on the teachings of Fleming and Stone. As noted above, this decision offers no position on the merits of the rejections based on obviousness-type double patenting. In summary, the decision of the examiner rejecting claims 19-22 and 31-33 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
)	
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